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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/516,753 | 03/01/2000 | Gregory Pinchasik | 2390/49701 | 3706 |

26646 7590 01/30/2002

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| EXAMINER |
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BUI, VY Q

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| ART UNIT | PAPER NUMBER |
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3731

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/516,753

Applicant(s)

PINCHASIK ET AL.

Examiner

Vy Q. Bui

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75, 77-92 and 95-119 is/are pending in the application.
- 4a) Of the above claim(s) 12-19, 51-66, 106 and 107 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 20-25, 27-32, 37-46, 48-50, 67-75, 77-92, 95-105 and 108-119 is/are rejected.
- 7) ☒ Claim(s) 8, 26, 33-36 and 47 is/are objected to.
- 8) ☒ Claim(s) 12-19, 51-66, 106 and 107 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION
Election/Restrictions

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species 1: Fig. 3.

Species 2: Fig. 5.

Species 3: Fig. 7.

Species 4: Fig. 11.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant has elected without traverse species 2, Fig. 5 for further examination (paper #6).

Claim Objections

Claims 95 and 97 are objected to because of the following informalities:

Claim 95: the recitation "the first loop and second containing sections" should have been -- the first and second loop containing sections --. Appropriate correction is required.

Claim 97: the second recitation "the third loop containing section" should be deleted.

Claims 33-36 dependent on a multiple dependent claim 32, therefore are objected to under 37 CFR 1.75(c) as being in improper form. See MPEP § 608.01(n). Accordingly, the claims 33-36 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, and 99 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 dependent to claim 1 reads on Fig. 5 of the present invention. Referring to claim 1 and Fig. 5, "the second and first junction points" should be circumferential aligned instead of "the second and third junction points" as recited in the claim. Clarification or correction is required.

Claim 99: "the higher frequency elements" lacks positive antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

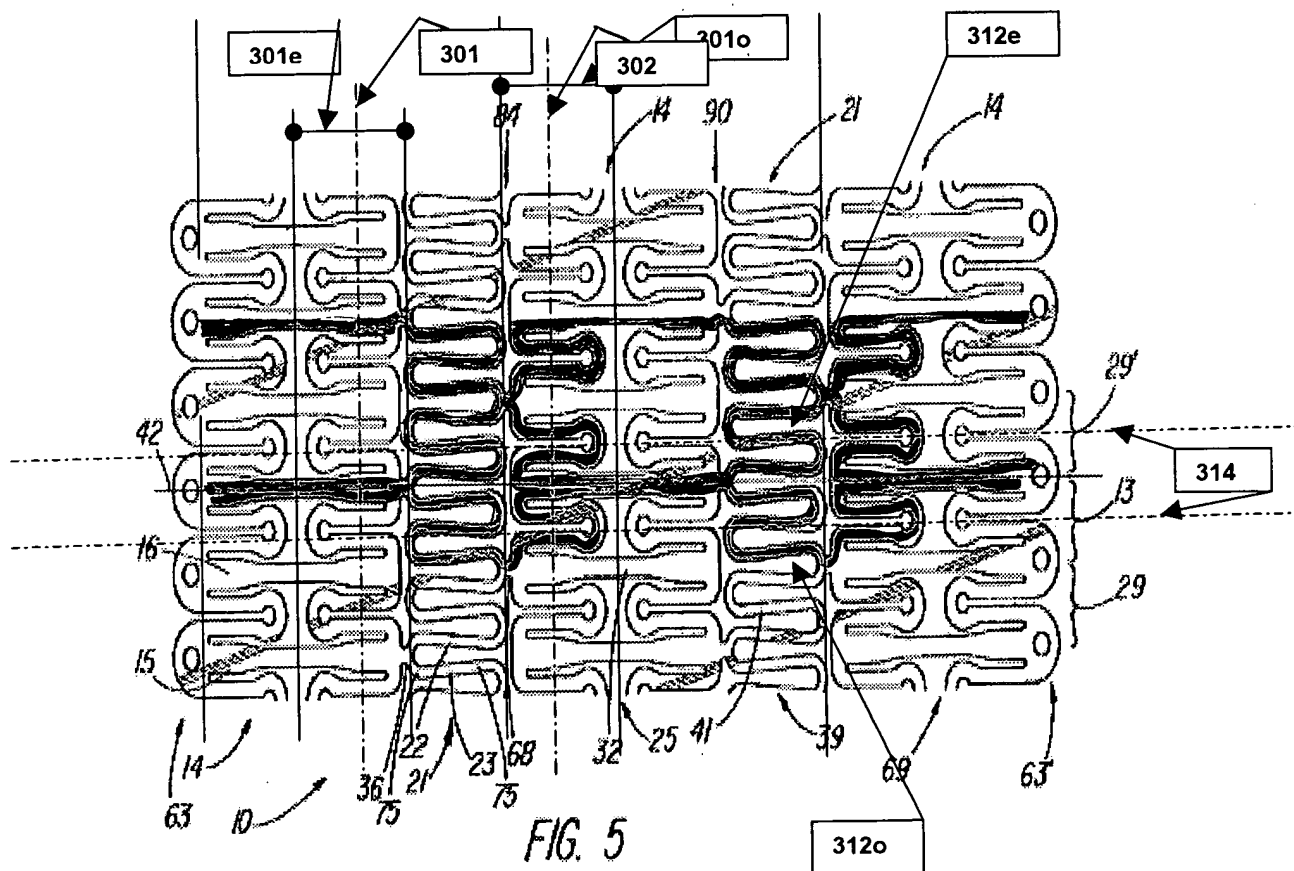
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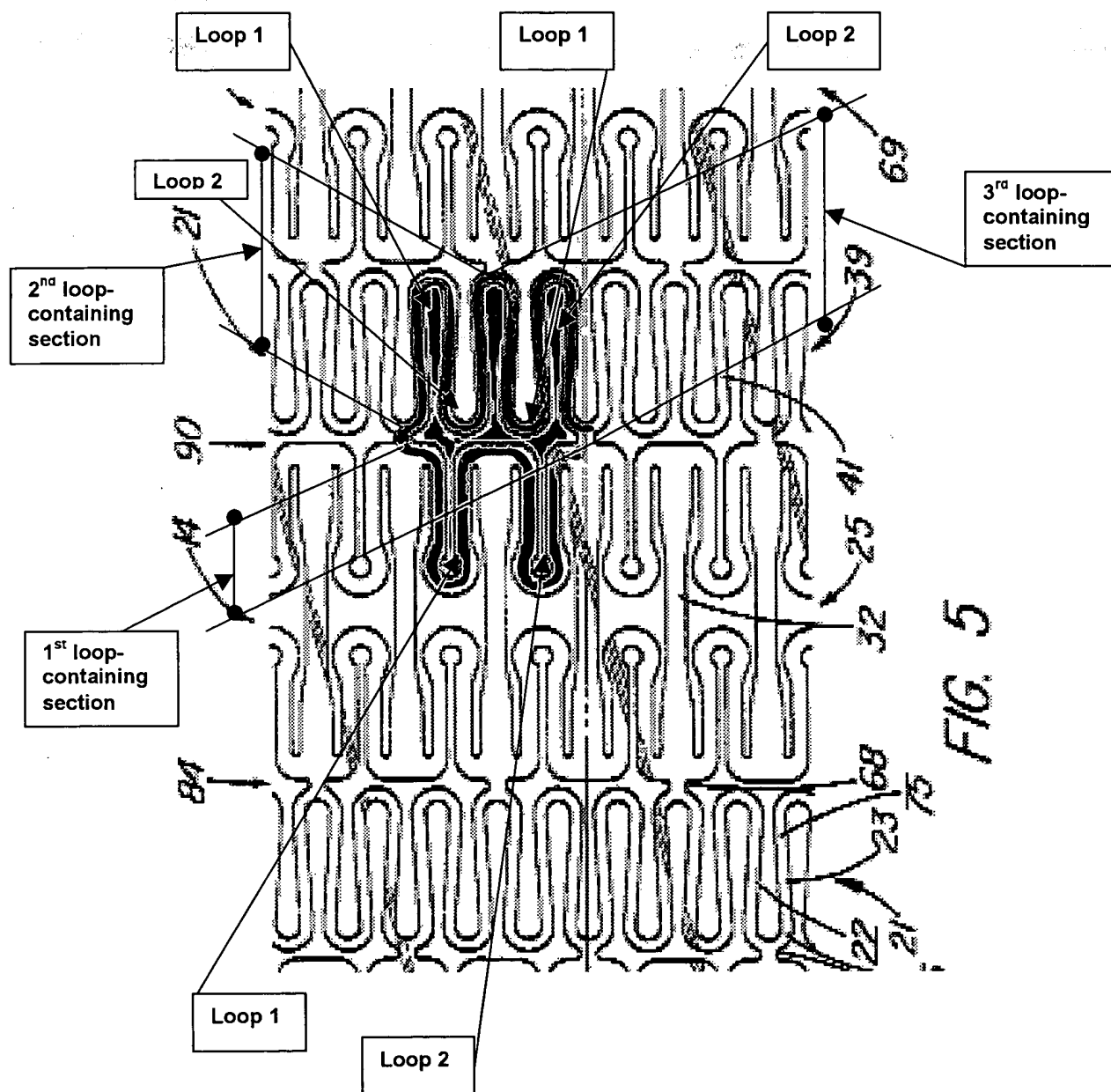
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-7, 9-11, 20-25, 27-32, 37-46, 48-50, 67-70, 72-75, 77-84, 86-88, 90-91, 95-105, 108-119 are rejected under 35 U.S.C. 102(e) as being anticipated by BERRY et al (6,231,598).

BERRY (Figs. 5 as shown below, for example) discloses a stent of stainless steel or nitinol:





As to claims 1-7, 9-10 and 45, BERRY (Fig. 5, page 4 this paper) discloses: 1st loop-containing section (highlighted in brown), 2nd loop-containing section (green) and 3rd loop-containing section (purple). The 1st, 2nd and 3rd loop-containing sections form triangular cells (highlighted in yellow), wherein each cell covers the same area. Notice that 1st loop-containing section has wider struts than the 2nd and 3rd loop-containing section, each loop-containing section has two loops, 1st and 2nd junction points are circumferential aligned.

Y → As to claim 11, BERRY (Fig. 28) discloses stent 10 having cells with circumferential lengths being longer than longitudinal lengths in expanded position.

As to claim 20, BERRY (column 15, lines 59-63) discloses the stent is coated for reduction of friction.

As to claims 21-25, 27-32, 37-46, and 48—50, BERRY (Fig. 5, page 3, this paper) discloses vertical meander/first meander pattern (highlighted in red) with centerlines 301 and horizontal meander/second meander pattern (in green) with centerlines 314. The centerlines 301 of the vertical meander/first meander pattern are orthogonal to the centerlines 314 of the second/horizontal meander patterns. The vertical/first meander patterns include even vertical/first meander patterns 310e and odd vertical/first meander patterns 310o. The second/horizontal meander patterns include even horizontal/second meander patterns 312e and odd horizontal/second meander patterns 312o. Notice that the first/vertical meander patterns have two loops per period and the second/horizontal meander patterns have 4 loops per period as shown.

As to claims 67-70, 72-75, 77-81, 83-84, 86-88, and 90-91, BERRY (Fig. 5, this paper) discloses stent of stainless steel or nitinol having 1st, 2nd, 3rd, 4th, 5th, 6th, 7th, 8th, 9th, and 10th members which are interconnected as recited in the claims. The curved junction portions of the members define loops (shown in Fig. 5, page 6) as recited in the claims.

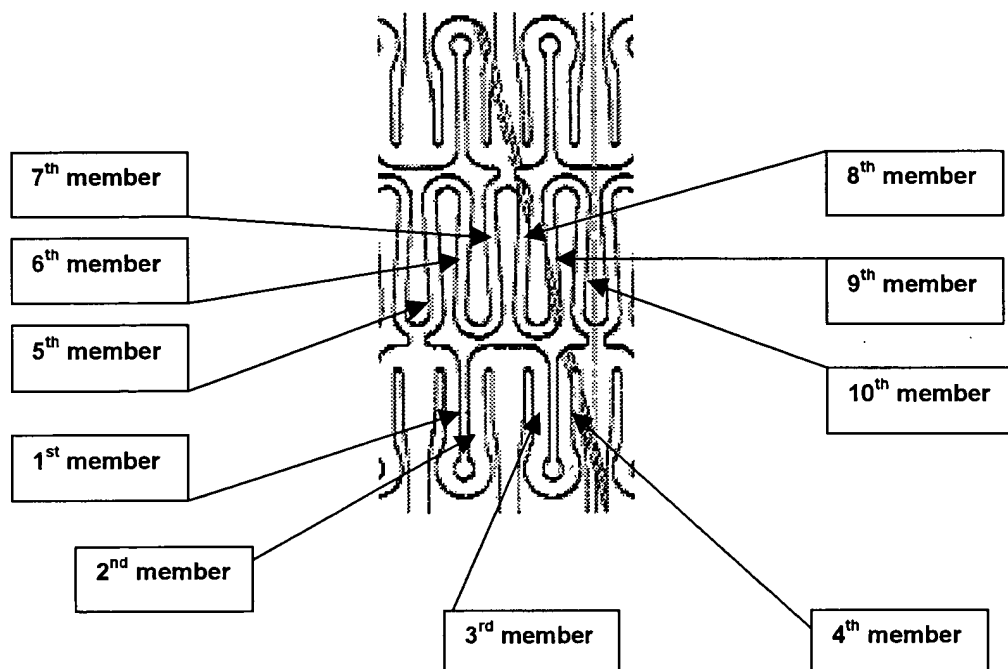
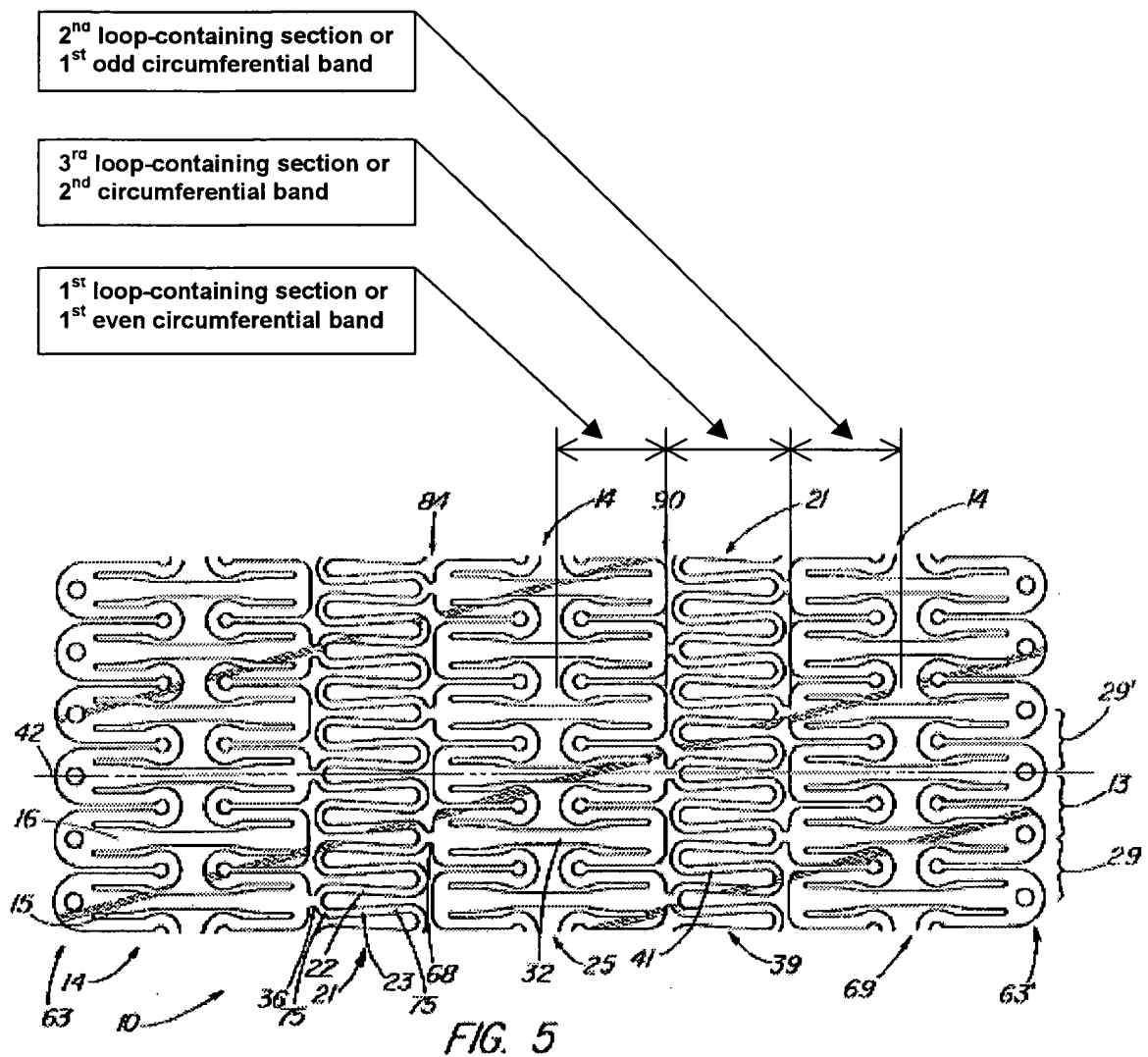


FIG. 5 (for reference of claims 67-92)

As to claims 95-104, 106-114, and 115-117, BEERY (Fig. 5, also Fig. 5 on page 7, this paper) discloses an even first loop containing section 301e/first circumferential band, an odd first loop containing section 301o/first circumferential band and third loop containing section/second circumferential band disposed between the first and second loop containing sections. The first or second loop containing sections (or the first circumferential band) and the third loop containing section (or the second circumferential band) defines loops as recited in the claims.

As to claim 105, BERRY (Fig. 28) discloses stent 10 having cells with circumferential lengths being longer than longitudinal lengths in expanded position.

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(For reference to claims 95-119)

As to claims 118-119, BERRY discloses the stent of stainless steel (balloon expanded) or Nitinol (self-expanded).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 71, 82, 85, 89, 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over BERRY et al (6,231,598).

As to claims 71, BERRY does not disclose at least one of the 1st, 2nd, 3rd, and 4th members has a length that is about twice the length of at least one of the 5th, 6th, 7th, 8th, 9th, and 10th members in the same space. However, it would have been an obvious matter of design choice to modify the dimension of the members accordingly to achieve the characteristics as recited in the claims, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

As to claims 82, 85, BERRY does not disclose that at least one or all of 1st, 2nd, 3rd, and 4th members are more flexible than at least one or all of the 5th, 6th, 7th, 8th, 9th, and 10th members. However, it would have been an obvious matter of design choice to modify the dimension of the members accordingly to achieve the characteristics as recited in the claims, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

As to claims 89, 92, BERRY does not disclose that at least one or more of the 5th, 6th, 7th, 8th, 9th, and 10th is/are more resistant to radial compression than at least one of 1st, 2nd, 3rd, and 4th members. However, it would have been an obvious matter of design choice to modify the dimension of the members accordingly to achieve the stent feature as recited in the claims, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

More over, change in size/dimension of the struts/beams of a stent to make them more flexible/rigid (more resistant to radial compression) is well-known in the art.

Allowable Subject Matter


Claims 8, 26, and 47 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is (703) 306-1382.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano, can be reached at (703) 308-2496. The fax number for this Unit is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at (703) 308-0858

VQB 
January 25, 2001.


MICHAEL J. MILANO
PRIMARY EXAMINER